

REMARKS

This responds to the Office Action mailed on February 11, 2008.

No claims are amended, canceled or added in this response; claims 6, 8-10 and 21-23 have been previously cancelled; as a result, claims 1-5, 7, 11-20 and 24 remain pending in this application.

§103 Rejection of the Claims

Claims 1-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gatto et al. (U.S. Patent 6,916,247) in view of Abrams, JR. et al. (U.S. Publication No. 2003/0208638), Hendrickson (U.S. Publication No. 2004/0087367 and Atwal et al. (U.S. Publication No. 2003/0061404). The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1336-37 (Fed.Cir. 2005). The legal conclusion that a claim is obvious within § 103(a) depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). The underlying factual issues set forth in *Graham* are as follows: (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested, by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); M.P.E.P. § 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); M.P.E.P. § 2143.03. As part of establishing a *prima facie* case of obviousness, the Examiner's analysis must show that some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.* To facilitate review, this analysis should be made

explicit. *KSR Int'l v. Teleflex Inc., et al.*, 127 S.Ct. 1727; 167 L.Ed 2d 705; 82 USPQ2d 1385 (2007) (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)).

Applicant further notes that in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.

Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985); MPEP § 2141.02. (emphasis added). The Examiner must also recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 U.S.P.Q.2d (BNA) 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir. 1990).

Applicant respectfully traverses the rejection. In view of the differences between Applicant's claims at issue and the cited references, Applicant respectfully submits the claims are not obvious in view of Gatto, Abrams, Hendrickson and Atwal. In general, the independent claims recite systems and methods that provide a three party handshake for providing a time service on a wagering game network. The time service first sends service information to a discovery agent, the discovery agent authorizes and authenticates the time service and in response publishes the service information. A client such as a wagering game machine desiring to use the time service obtains the service information from the discovery agent and uses the service information to contact the time service. Applicant respectfully submits that when the claims are considered as a whole, the cited references do not teach or suggest the present invention as claimed in the independent claims.

For example, at least one difference between cited references and the claims at issue may be found in independent claim 1, which recites in part "determining by the discovery agent if the time service is authentic and authorized." Independent claim 15 recites similar language regarding a discovery agent that determines if a time service is authentic and authorized. The Office Action correctly states that Gatto does not disclose the recited language. However, the Office Action goes on to assert that Atwal discloses that a client is verified to be authorized to utilize the service (citing paragraph 52) and further that clients subject to authorization include

service providers (citing paragraph 43). Applicant respectfully disagrees with this interpretation of Atwal for several reason. First, claims 1 and 15 recite that a discovery service provides authentication and authorization. Neither the cited section of Atwal nor Atwal in general discloses that a discovery service authenticates and authorizes a service. Second, Atwal discloses that a method call is authenticated as coming from a particular client. Atwal does not disclose that the client itself is authenticated before it is allowed to be on the wagering game network. Further, Atwal does not disclose that a service is authorized before it allowed to be on a wagering game network. All of the activity in Atwal presumes that the client is already available on a network. As a result, Atwal does not disclose determining by a discovery agent if the time service is authentic and authorized.

Further, Applicant has reviewed Abrams and Hendrickson and can find no disclosure of determining by a discovery agent if the time service is authentic and authorized.

For all of the reasons above, none of Gatto, Abrams, Hendrickson or Atwal, alone or in combination, discloses determining by a discovery agent if the time service is authentic and authorized. Therefore there are differences between claims 1 and 15 and the cited references. As a result, claims 1 and 15 are not obvious in view of the combination of Gatto, Abrams, Hendrickson and Atwal. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1 and 15.

Claims 6, 8-10 and 21-23 were cancelled in the response filed October 25, 2007, therefore the rejections of these claims is believed moot.

Claims 2-5, 7 and 11-14 depend from claim 1 and claims 16-20 and 24 depend from claim 15. These dependent claims inherit the elements of their respective base claims 1 and 15 and are not obvious in view of the combination of Gatto, Abrams, Hendrickson and Atwal for at least the reasons discussed above regarding their respective base claims 1 and 15.

Even if the combination of Gatto, Abrams, Hendrickson and Atwal disclosed the elements of Applicant's claims (which is not admitted), "[a] factfinder should be aware. . . of the distortion caused by hindsight bias and must be cautious of argument reliant upon *ex post* reasoning." *KSR Int'l Co.* at 1397. *See also Graham* at 474. The Examiner cannot use the Appellant's structure as a "template" and simply select elements from the references to

reconstruct the claimed invention. *In re Gorman*, 933 F.2d 982, 987, 18 U.S.P.Q.2d (BNA) 1885, 1888 (Fed. Cir. 1991).

The Office Action uses four references in the rejection of claims 1-5, 7, 11-20 and 24. This is highly suggestive that the Examiner is using Applicant's structure as a template and selecting individual elements from each reference in a hindsight reconstruction of Applicant's claimed invention. Further, the use of individual elements from four references suggests that the Examiner is merely considering whether the differences are obvious, not the invention as a whole.

For all of the above reasons, Applicant respectfully submits that pending claims 1-5, 7, 11-20 and 24 are not obvious in view of Gatto, Abrams, Hendrickson and Atwal. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1-5, 7, 11-20 and 24.

Reservation of Rights

In the interest of clarity and brevity, Applicant may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.



AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 10/802,701

Filing Date: March 17, 2004

Title: TIME SERVICE IN A SERVICE-ORIENTED GAMING NETWORK ENVIRONMENT

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Dkt: 1842.029US1

CONCLUSION

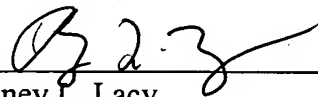
Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at (612) 373-6954 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date May 12, 2008

By 
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 12 day of May, 2008.

Zhakalazky M. Carrion
Name


Signature